



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,514	08/20/1999	CONRAD B. MYRICK	70-99-002	9234

7590 12/27/2004

David G. Wille, Esq.
BAKER BOTTS L. L. P.
2001 Ross Avenue
Suite 600
Dallas, TX 75201-2980

EXAMINER

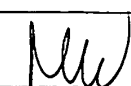
COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/378,514	Applicant(s) MYRICK ET AL.	
	Examiner Edward R. Cosimano	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 27 September 2004.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 2-11 is/are pending in the application.

4a) Of the above claim(s) none is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 2-12 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 11/2/01; 5/22/03 & 10/30/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No: _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The combined set of drawings filed 02 November 2001, 22 May 2003 and 30 October 2003 are acceptable to the examiner.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

4. Claims 2-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 In regard to claim 2, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 2, lines 5-6, why the "supporting information technology" is identified, since:

(1) this information is not in fact used by the remainder of the claimed invention;

(2) the analysis of the information technology requirements of lines 14-15 does not use or consider the identified supporting information technology; and

(3) the generating of a plan for implementing and deployment of information technology of lines 16-19, does not use or consider the identified supporting information technology.

B) in regard to claim 2, lines 14, why the “information technology requirements” are analyzed, since:

(1) the results of this analysis is not in fact used by the remainder of the claimed invention; and

(2) the generating of a plan for implementing and deployment of information technology of lines 16-19, does not use or consider the analyzed information technology requirements.

C) in regard to claim 4, how the “information technology plan in support of the aforementioned plans” would fit into the remainder of the claimed invention, since the information technology of the business is not considered in the generating of the “overall architecture” as recited in the invention of claim 2.

D) in regard to claims 6-9, how either the “information architecture” or the “application architecture” or the “technology infrastructure” or the “enterprise information technology management framework” would fit into the remainder of the claimed invention, since non of these claimed features are considered when generating of the “overall architecture” as recited in the invention of claim 2.

E) in regard to claim 12, lines 5-6, why the “supporting information technology” is identified, since:

(1) this information is not in fact used by the remainder of the claimed invention;

(2) the generating of an overall architecture of lines 8-29, does not use or consider the identified supporting information technology when these limitations allude to information technology; and

(3) the generating of a plan for implementing and deployment of information technology, does not use or consider the identified supporting information technology.

4.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

5.1 Claims 2-12 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

5.1.1 The instant claims recite a method comprising a series of steps to be performed, (claims 2-11), and a manufacture comprising program code, (claim 12), which have a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

5.1.2 In regard to claims 2-12, the invention as set forth in these claims merely describes:

A) creating a map of an enterprise/business when identifying a entities in the business and generating an overall architecture for the enterprise/business;

B) creating a model of the enterprise/business when implementing a common language and generating a graphical representation of the enterprise/business that comprises a number of different business related operational structures;

C) determining the IT requirements for the enterprise/business by analyzing the enterprise/business; and

D) generating a plan for deployment of the determined IT requirements for the identified entities.

Where, in regard to:

A) claims 2 & 12, although the “generating an overall architecture” functions/actions of claims 2 & 12 and the “generating a graphical representation” (claim 2, lines 10-13) may seem to be physical actions/functions, however, as disclosed these functions/actions are merely directed to an abstract modeling of the “business” and the “integrated business and information technology framework”;

B) claims 2 & 12, although the “generating a plan for implementation and deployment of information technology” function/action may seem to be a physical action/function, however, as disclosed this function/action is merely directed to the abstract modeling of a plan to implement and deploy information technology within the “integrated business and information technology framework”, because as recited in this claim the plan is in fact not implemented whether or not it may be displayed in some manner; and

C) claim 12, although the “graphically displaying the overall architecture of the business; graphically displaying how the information technology is to be implemented and deployed within the overall architecture response to the generated plan” appears to add physical actions/functions it is noted that as disclosed the graphic displays are in fact a representation of an abstract model that as recited in the claims is not used or implemented.

However, the process/manufacture as recited in these claims does not apply the result of either the claim as a whole or the manipulations of data as recited in these claims in such a manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application within the technological or useful arts. It is noted that claims 3-11 merely define the nature and function of various aspects of the invention.

5.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or

C) is operated or controlled by the result of the invention recited in these claims.

5.1.4 It is further noted in regard to the claims 2-12, that applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed; or

C) a practical use of the claimed invention by any physical system or device or method outside of a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations that would be considered as going beyond the manipulation of "abstract ideas" as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological/useful arts as recited in the claims;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of "constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model" was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Hence, the invention of claims 2-12 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of collecting, analyzing and displaying information with out a concrete and tangible application of the abstract idea or the results of the recited manipulations, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S.

Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

5.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

5.1.6 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application.

5.1.7 Hence, claims 2-12, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

5.2 Claim 1 is rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

5.2.1 The instant claims recite a system/device/manufacture, (claim 12), which has a disclosed practical application in the technological arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device that contains a data structure comprising series of steps that as claimed could be but are not necessarily to be performed on a computer.

5.2.2 It is further noted that applicant has not recited a specific machine since the operations recited in the claim are merely to illustrate the operations of the instant invention since these operations are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claim 12 as a disembodied storage device, i.e. memory, that stores a

computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

5.2.3 In view of the above, the invention recited in claim 12, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claim 12 does not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

5.2.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Art Unit: 3629

5.2.5 Hence, claim 12 is directed to non-statutory subject matter.

5.3 Claims 2-12 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

5.3.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

5.3.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non-statutory subject matter.

5.3.3 As can be seen from claims 2-11, these claims are directed to a series of steps/actions/functions, which as set forth above in regard to the rejection of claims 2-12 under 35 U.S.C. § 112 2nd paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

5.3.4 Further on regard to the computer useable/readable medium of claim 12, the recited limitations are not clearly and definitely interconnected to one another and a device to execute the program code/instructions on the media so as to provide a useful operative and useful manufacture within the meaning of machine or process as used in 35 U.S.C. § 101.

5.4 Claims 2-12 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 2-12, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2nd paragraph as set forth above.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the 35 U.S.C. § 101 rejection, since:

A) the invention as recited in claims 2-11 does not generate a concrete and tangible result because the claims merely manipulate information/data that is neither externally used or manipulated by the invention and hence these claims merely manipulate an abstract idea which as claimed is not tied to the physical world in such a manner as to produce a concrete and tangible result in the technological arts, see In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994) where claims which implied physical actions were held to be directed to an abstract idea.

B) the invention as recited in claim 12 does not generate a concrete and tangible result because:

(1) the claims recite functional language that can not be implemented in a physical manner, since a computer readable medium clearly can not perform the functions recited in claim 12; and

(2) even if the function language was to be implemented, then claim 12 would merely recite functional language that is intended to manipulate information/data that is neither externally used or manipulated by the invention.

Hence this claim merely manipulates an abstract idea which as claimed is not tied to the physical world in such a manner as to produce a concrete and tangible result in the technological arts.

Hence, applicant's argument's are non persuasive.

7. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783.

Application/Control Number: 09/378,514


Page 12

Art Unit: 3629

The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

- 8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.
- 8.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.
- 8.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/16/04


Edward R. Cosimano
Primary Examiner A.U. 3629